



UNITED STATES PATENT AND TRADEMARK OFFICE

14
UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/031,450	08/06/2002	Assaf Dekel	110/01309	6918

44909 7590 02/09/2005

FENSTER & COMPANY INTELLECTUAL PROPERTY 2002 LTD.
C/O REED SMITH LLP
599 LEXINGTON AVENUE, 29TH FLOOR
NEW YORK, NY 10022-7650

EXAMINER

DAVIS, DANIEL J

ART UNIT	PAPER NUMBER
----------	--------------

3731

DATE MAILED: 02/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/031,450

Applicant(s)

DEKEL, ASSAF

Examiner

D. Jacob Davis

Art Unit

3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 January 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-56 is/are pending in the application.
- 4a) Of the above claim(s) 29-31 and 33-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28, 32, 37-56 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12/9/02.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of claims 1-28, 32 and 37-56 in the reply filed on January 4, 2005 is acknowledged. Applicant traverses, "the different species are related, i.e., not independent, under the definition in MPEP 802.01 and 808.01, in which the term "independent" is defined to mean that there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation, or effect."

This is not found persuasive since the definition of "independent" as disclosed is "species under a genus which species are not usable together as disclosed." Since the species are not usable together as disclosed, the inventions are independent and the election of species requirement is deemed valid.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 28 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it

Art Unit: 3731

pertains, or with which it is most nearly connected, to make and/or use the invention.

The specific bioabsorbable materials are not disclosed. No new matter may be entered.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-14, 24-27, 32, 37, 39, 47 and 48 are rejected under 35 USC 102(b) as being anticipated by U.S. Patent No. 2,372,553 to Coddington. Coddington discloses an apparatus for removing bone comprising a handle 14, first and second extensions 13 and a flexible rasp. The outer surfaces of the extensions contacting the rasp 10 comprise the first and second tips. The central portions of the extensions 13 comprise the pick reel/rasp advancer. The device comprises a shield 15. The water X is capable of removing tissue as is the water accumulated by the shield 15. Alternatively, the shield may comprise the smooth backing 10 as illustrated in Fig. 4. The shield of the smooth backing and the rasp are fully capable of being removed, inverted, and replaced

to change the "relative positions." The central portion of the extensions 13 comprises a resting point. The water X is a source of cleaning fluid.

Claims 1, 42, 43 and 50 are rejected under 35 USC 102(b) as being anticipated by U.S. Patent No. 2,355,124 to Testo. Testo discloses a handle 13, first and second extensions extending from the handle 13, a flexible rasp 7, and tips comprising the outer surfaces of the wheels 16. The length of the tips is adjustable, thus adjusting the active length. The device comprises a means for affixing 17.

Claims 1 and 52-54 are rejected under 35 USC 102(b) as being anticipated by U.S. Patent No. 3,523,348 to Nilsson. Nilsson discloses a handle E, extensions D on both sides of the handle, and a flexible rasp C extending between two tips A and B. The device comprises a spring F used to tension the rasp. The threads on the handle E act as a gauge that can measure the tension.

Claim 1, 55 and 56 are rejected under 35 USC 102(b) as being anticipated by U.S. Patent No. 6,068,542 to Hosokai. Hosokai discloses a handle 22, a first extension extending to the left of the handle 22 attached to a tip (the roller) and a second extension extending to the right of the handle attached to tip (roller 27). The flexible "rasp" T has a "leader" comprising the first portion of the rasp T used to thread the rasp T through the machine and attach it to the reel.

Art Unit: 3731

The device comprises a means for guiding 27, a means for holding 22, and a means for moving 25 and 26.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 15-19, 40 and 41 are rejected under 35 USC 103(a) as being unpatentable over U.S. Patent No. 2,372,553 to Coddington. Coddington fails to disclose that the width of the rasp is less than 2 mm. Nevertheless, it has been held that mere changes in size are within the level of ordinary skill in the art. It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the rasp width less than 2 mm.

The length of the rasp is not specified. Nevertheless, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the rasp between 1 and 3 meters or any length as needed.

Claims 20-23, 44-46 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 2,355,124 to Testo. Testo discloses a groove 9 indented within the rasp. The patent is silent regarding the thickness of the rasp at the

Art Unit: 3731

groove. Nevertheless, it has been held that mere changes in size are within the level of ordinary skill in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the thickness of the rasp at the groove less than 0.1 mm.

Furthermore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the active length sufficient to pass through four vertebra of an adult human, or any length as needed by a user.

Testo discloses a rasp advancer, but fails to disclose that the rasp may reciprocate. Nevertheless, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the reciprocate the band tool as needed by a user.

Claim 38 is rejected under 35 USC 103(a) as being unpatentable over U.S. Patent No. 2,355,124 to Testo in view of U.S. Patent No. 5,713,785 to Nishio. Testo fails to disclose a vacuum source. Nishio teaches a vacuum source for "exhausting dust emitted during the sanding." It would have been obvious to one of ordinary skill in the art at the time the invention was made to include a vacuum source as taught by Nishio in order to capture airborne particles.


Art Unit: 3731

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. Jacob Davis whose telephone number is (571) 272-4693. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan T. Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DJD


GLENN K. DAWSON
PRIMARY EXAMINER